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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,091	08/27/2003	Anthony J. Baerlocher	0112300-1411	4932
7590 Bell, Boyd & Lloyd LLC P.O. Box 1135 Chicago, IL 60690-1135				
EXAMINER				
HOEL, MATTHEW D				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
05/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/649,091

**Applicant(s)**

BAERLOCHER, ANTHONY J.

**Examiner**

Matthew D. Hoel

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 1-13,15,16,19-35,37-41,43-59,61,64-76,78-93,103,117,121,125 and 126.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-13,15,16,19-35,37-41,43-59,61,64-76,78-93,103,117,121,125 and 126.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 to 13, 15, 16, 19 to 35, 37 to 41, 43 to 56, 103, and 125 (1, 28, 47, 103, and their dependents), drawn to an electronic gaming device comprising a display, input, a processor and memory, the gaming device having a first plurality of symbol indicators associated with a first plurality of award symbols, a second plurality of symbol indicators, associated with a second plurality of award symbols, wherein the symbol indicators are movable relative to the award symbols, classified in class 463, subclass 16, pertaining to electronic games of chance.
  - II. Claims 57 to 59, 61, 64 to 76, 78 to 93, 117, 121, and 126 (57, 72, 84, 117, 121, and their dependents), drawn to a method of playing a game on a gaming device, not necessarily that of Group I, the game comprising first symbol indicators associated with first award symbols, second symbol indicators associated with second award symbols, and the symbol indicators moving relative to the award symbols, classified in class 273, subclass 141R, pertaining to chance devices comprising a rotating pointer.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be

practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case Group II can be practiced on a gaming board with spinning indicators, a gaming device, but not necessarily the electronic gaming device cited in Group II. The method of Group II can be carried out by a board game with spinners mounted into the board, for example, with a rotatable spinner with several arrows in it mounted to the center of the game board, with several rotatable disks mounted on the game board around the central spinner with the rotatable disks each bearing plural indicia around their peripheries. The steps of picking one of the first plurality of symbol indicators, picking one of the second plurality of symbol indicator, "activating" the picked symbol indicators (or pointers of central rotatable spinner) by betting on them, moving the symbol indicators relative to the award indicators carrying award symbols (rotatable disks bearing plural award symbols), could be accomplished by humans carrying out the steps of the method by spinning the central spinner with arrows (symbol indicators) and spinning the award indicators with award symbols (rotatable disks with indicia or award symbols) and seeing where they stop spinning. The total of the award to be issued could be calculated by the player or a dealer. An example, for illustrative purposes only, of one possible apparatus that could be used to implement the method claims is Eickershoff (U.S. patent 636,508 A, issued Nov. 7<sup>th</sup>, 1899). Although such devices are seldom used today, they are still publicly available as prior art and are known to the public; the examiner believes that devices such as these could be used to practice Group II, and would be a substantially different type of device used to practice the

method of Group II than the devices cited in Group I. The examiner thus believes there would be divergent searches for these two groups of claims.

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

4. **Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

5. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

6. If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

7. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. A telephone call was made to atty. Patricia Chidiac on Monday, May 18<sup>th</sup>, 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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